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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,267	02/06/2006	Wilhelm Muller		4096

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EXAMINER	
LAM, DUNG LE	

ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,267

Applicant(s)

MULLER, WILHELM

Examiner

DUNG LAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)–(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The Information Disclosure Statement submitted on 2/11/05 has been considered by the examiner (see attached PTO-1449 form).

Specification

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).

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- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The specification is missing the above underlined headings.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites,

1. A method for handling a location data request or location request relating to a subscriber in a mobile radio network, comprising:

(a). upon receipt of a request from a first location request handling device at a subscriber database of a mobile radio network, ***switching device address data of a switching device, via which the subscriber can currently be reached;***

(b). ***instead of switching the device address data, specifying,*** via the subscriber database, to the first location request handling device in a response location request handling device address data representing the address of a further location request handling device; and

(c) ***if*** it is a request from the location request handling device of a version, according to which version there is provision for the location request handling device to receive switching device address data from the subscriber database as a response.

The above bolded limitation (a) is calling for a step of "switching device address data of a device". Yet, in the very next limitation b, the phrase "instead of switching device address data of a device, specifying " seems to suggest that the previous bolded step a not be performed because of the word "instead". Thus, it is not clear why the bolded section of limitation 1a is included in the claim.

Regarding limitation 1c, after the "if" condition, there is no positively recited steps being performed because there is no verb in an active form provided in the claim (e.g. specifying**ing**, providing**ing**, transmitting**ing**....). Thus, it is also not clear, what step/action is being claimed in limitation 1c.

Similarly, claim 11 is also rejected for the same reasons as claim 1 above.

For examination purpose, the examiner will examine the claim with the broadest reasonable interpretation.

Claim Objections

Claims 4 and 5 objected to because of the following informalities:

Claim 4 recites "**the** first older version location request", which was not previously mentioned. The examiner suggests changing the phrase to -- **a** first older version location request handling device--.

Claim 5 recites "**it**" a few times. The examiner suggests changing "it" to the actual name to make the claim language clearer.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1, 3-6, 8, and 10-11 rejected under 35 U.S.C. 102(b) as being anticipated by **Havanis** (US Patent No. 6501955)

4. Regarding claim 1, **Havanis** teaches a method for handling a location data request or location request relating to a subscriber in a mobile radio network, (Fig. 4) comprising:

- upon receipt of a request from a first location request handling device at a subscriber database of a mobile radio network, switching device address data of a switching device, via which the subscriber can currently be reached (C4 L20-53; Step 400-415 Fig. 5);
- instead of switching the device address data, specifying, via the subscriber database, to the first location request handling device in a response location request handling device address data representing the address of a further location request handling device (step 435-440; if serving device is serving MLC, MLC's address is looked up C4 L53-58); and

- if it is a request from the location request handling device of a version, according to which version there is provision for the location request handling device to receive switching device address data from the subscriber database as a response (Step 440-445; C4 L20-43; if the GMLC is the serving device then HLR sends MSC address is sent to GMLC).
5. Regarding claim **3**, **Havinis** teaches the method according to claim 1, wherein the further location request handling device stores profile data of the subscriber, which specifies whether and under what conditions the location request relating to the subscriber should be processed and/or responded to (serving MLC checks user subscription C4 L44-52).
6. Regarding claim **4**, **Havinis** teaches the method according to claim 1, wherein the first older version location request handling device sends the request to the subscriber database after it receives a request from an LCS client (C4 L52-65).
7. Regarding claim **5**, **Havinis** teaches the method according to claim 1, wherein the first location request handling device sends the location request to the address of the further location request handling device, which forwards it to the address of a switching device, which was specified thereto by the subscriber database in response to its request to the subscriber database (C4 L52-65).
8. Regarding claim **6**, **Havinis** teaches the method according to claim 4, except wherein the request includes data of the subscriber to be located identifying the subscriber (C4 L13-19).

9. Regarding claim **8**, **Havinis** teaches the method according to claim 1, wherein the version of the location request handling device is identified by the subscriber database from the non-extended format of the request (the serving MLC is look).
10. Regarding claim **10**, **Havinis** teaches the method according to claim 1, wherein the further location request handling device profile data of the subscriber, in respect of whom a location request is to be implemented, is verified and the further location request handling device contacts the switching device specified to it, if the profile data of the subscriber shows that the location request relating to the subscriber should be carried out. (C4 L48- C5 L6).
11. Regarding claim **11**, it has the same corresponding limitations as that of method claim 1. Therefore it is rejected for the same reasons as claim 1.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim(s) **2 and 9** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over **Havanis** (US Patent No. 6501955) in view of **3GPP** (3gpp Ts 23.271 v6.0.0).
14. Regarding claim **2**, **Havinis** teaches the method according to claim 1, except wherein the further location request handling device is a location request handling

device in a home network of the subscriber . In an analogous art, 3GPP teaches an LCS arrangement where the signals has to travel from a RGMMLC to a home HGMLC (fig. 6.1-2). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to combine Havanis' teaching with 3GPP to allow a client to communicate with a home GMLC of a subscriber via a RGMMLC.

15. Regarding claim **9**, **Havanis** teaches the method according to claim 1, wherein the version of the location request handling device is identified from a database (C4 L53-65). However, Havanis does not specifically teach a Lh interface used. In an analogous art, 3GPP teaches GMLC receiving various types of data from the HLR data via the Lh interface. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to provide the detailed data via the Lh interface without having to establish another interface.

16. Claim(s) **7** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over **Havanis** (US Patent No. 6501955).

17. Regarding claim **7**, **Havanis** teaches the method according to one claim 1, wherein the location request handling device address data has a same format as switching device address data. However, it is common sense for the GMLC and MSC to have the same address format so that there is no need for address translation to reduce complexity. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have the same format for the addresses from different network components to avoid the complexity of address translation.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUNG LAM whose telephone number is (571) 272-6497. The examiner can normally be reached on M - F 9 - 5:30 pm, Every Other Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617